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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,462	12/13/2004	Tadashi Nakamura	TOS-157-USA-PCT	7551
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TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER KAROL, JODY LYNN	
			ART UNIT 1609	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/501,462

Applicant(s)

NAKAMURA ET AL.

Examiner

Jody L. Karol

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application is a 371 of PCT/JP02/00344, International Filing Date: 1/18/2002. Claims 1-4 have been amended and claims 5-7 have been added as per applicant's preliminary amendment dated 7/14/2004. Accordingly, claims 1-7 are pending and examined on the merits herein.

#### ***Information Disclosure Statement***

1. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Priority***

2. Applicant has not claimed priority to prior foreign application JP 2001-0005769, filed on 1/12/2001. It is noted that the applicant is not eligible for foreign priority since PCT/JP02/00344 was filed more than twelve months after JP 2001-0005769.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains more than one paragraph. Correction is required. See MPEP § 608.01(b).

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

6. The use of the trademarks Veegum®, Kunipia®, Laponite®, Dimonite®, and Benton 38® have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

7. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that a microgel is obtained by dissolving a hydrophilic compound having a gelation ability in water or an aqueous component and then "letting it cool down and solidify to form a gel." The claims do not indicate that the gel mixture was ever heated, and therefore it is unclear if the mixture was heated, and then allowed to

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stand until cooled to room temperature, or if the mixture was cooled in some other manner. Claims 2-7 are rejected for being dependent on a rejected base claim.

Correction is required.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 11 and 16 of copending Application No. 09/936317 in view of the machine translation of unexamined patent publication JP 2000-219609 A by Sato et al.

Although the conflicting claims are not identical, they are not patentably distinct because the instant claims are drawn to a composition comprising a microgel having an

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average particle size of 0.1-1,000 micrometers obtained by dissolving a hydrophilic compound having a gelation ability in water or an aqueous component, letting it cool down and solidify to form a gel, and pulverizing said gel, while the copending claims are drawn to the process for producing the microgel. Both claim sets further limit the particle size of the microgel to 1 to 300 micrometers and list agar, gelatin, gellan gum, and alginic acid as possible hydrophilic compounds. The instant claims further require the composition to contain an organophilic clay mineral, an oil component, and an emulsifier with an HLB value no greater than 7. The copending claims also claim a process for producing an external cosmetic composition, but do not specify the other ingredients present in the cosmetic composition. However, water-in-oil emulsions that contain organophilic clay minerals in the oil phase are well-known cosmetic formulations. For example, Sato et al. discloses a water-in-oil emulsified composition comprising a silicone oil phase, an organically modified clay mineral, and emulsion aid of having an HLB value of 7 or less that is useful in cosmetic compositions because of its high stability at low temperatures (see abstract). Therefore, it would be obvious to one of ordinary skill in the art that a cosmetic composition containing a microgel could be a water-in-oil emulsion where the oil phase contains an organophilic clay mineral and an emulsifier with an HLB value less than 7, so as to increase the stability of the composition. Accordingly, the instant claims 1-7 are obvious over the copending claims 1, 5, 7, 11 and 16 in view of Sato et al. (JP 2000-219609 A), and thus are not patentably distinct over the copending Application No. 09/936317.

This is a provisional obviousness-type double patenting rejection.



***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delrieu et al. (US 5,961,990) in view of Sato et al. (JP 2000-219609 A).

Claim 1 is directed to a water-in-oil emulsified composition comprising (a) 0.1-20% by weight organophilic clay mineral, (b) 10-70% by weight oil component, 0.1-10% by weight emulsifier having an HLB value of not more than 7, and (d) 0.1-90% by weight microgel having an average particle size of 0.1 to 1,000 micrometers. The microgel is said to be obtained by dissolving a hydrophilic compound having a gelation ability in water or an aqueous component, letting it cool down and solidify to form a gel, and pulverizing said gel. Claim 2 further limits the particle size of the microgel to 1-300 micrometers. Claim 3 specifies that the hydrophilic compound is selected from the group consisting of agar, carrageenan, curdlan, gelatin, gellan gum, and alginic acid. Claims 4-7 are directed to cosmetic compositions of claims 1-3. The term "comprising" is interpreted to be broad and open, indicating that other components may be present in the composition.

Delrieu et al. teaches water-in-oil cosmetic compositions that contain agar gel particles (see column 4, lines 6-9 and columns 11-12, lines 63-67, 1-17). Delrieu et al. also specifies that the gel beads can be present in a cosmetic composition in 0.1 to 90% by weight of the total composition (see column 12, lines 18-22) and that the gel particles can range in size between 50-10,000 micrometers (see column 5, lines 42-52).

However, Delrieu et al. does not disclose any cosmetic compositions where the other ingredients are specifically disclosed, or the specific percentages for the components. Delrieu et al. only discloses that recipes and ingredients for cosmetic compositions are well known to those of ordinary skill in the art (see column 12, lines 3-9).

Sato et al. teaches water-in-oil emulsified compositions comprising a silicone oil phase, an organically modified clay mineral, and an emulsion aid having an HLB of 7 or less, and is important for its disclosure of an organophilic clay mineral and emulsifier having an HLB value of 7 or less in the oil phase (see abstract). The clay mineral is present in the composition in 0.1 to 10% by weight, and the emulsifier is present in 0.1 to 15% by weight (see page 10, section 33 and page 11, section 42). This significantly overlaps with the % weights listed in the instant claims for these components. Sato et al. also discloses that the compositions are useful as cosmetic compositions and afford high stability at low temperatures (see abstract).

It is well known in the art that blending a solid into the oil phase of a water-in-oil emulsion increases the viscosity of the oil phase, resulting in emulsions with higher stability. Therefore, it would be obvious to one of ordinary skill in the art, at the time the

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invention was made, to include an emulsifier and an organophilic clay mineral in the oil phase of a water-in-oil emulsion as taught in Sato et al., to increase the viscosity of the oil phase and the overall stability of the emulsion of Delrieu et al.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsuzaki et al. (US 6,585,986 B2), published on 11/22/2001, is important for its disclosure of organically modified water swelling clay minerals mixed with oils to obtain gels or emulsified compositions with superior stability.

No claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jody L. Karol whose telephone number is (571) 274-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK

*Jody Karol*

*Michael Meller*  
MICHAEL MELLER  
PRIMARY EXAMINER